

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1, 3-11, and 14-18 remain in the application.

In the third paragraph on page 2 of the Office action, claims 1, 14, 16, and 18 have been rejected as being obvious over Pensavecchia (U.S. Patent No. 5,660,108) in view of Stark et al. (U.S. Patent No. 5,040,460) (hereinafter "Stark") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, inter alia:

a second printing machine having a second impression cylinder and a feed drum disposed immediately up-line of the second

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

impression cylinder for feeding the sheets directly to the second impression cylinder.

Claim 1 also calls for, *inter alia*:

an adjusting device assigned to the feed drum, the feed drum being at least partially displaceable by the adjusting device for adjusting and correcting registration of the feed drum.

As correctly stated by the Examiner on page 3 of the Office action, Pensavecchia does not disclose displacing the feed drums (72a and 72b) for adjusting and correcting registration of the feed drums. Therefore, Pensavecchia does not disclose the feed drum being at least partially displaceable by the adjusting device for adjusting and correcting registration of the feed drum, as recited in claim 1 of the instant application.

The Examiner cites the Stark reference as disclosing a "sheet feed drum 4" which has a sheet register assembly for adjusting the "sheet feed drum 4" in order to make up for the deficiencies of Pensavecchia. The Examiner also stated that it would have been obvious to those having ordinary skill in the art to provide the sheet printing machine of Pensavecchia with the sheet feed drum adjustment as disclosed in Stark.

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

However, as will be seen from the following comments, Stark teaches away from away from the combination as suggested by the Examiner.

The Stark reference discloses a linking perfecting assembly having a register drum (4) and a transfer drum (3). The Stark reference discloses that "after the sheet has been released from the register drum 4, it passes to a second or trailing transfer drum 3 and then goes to an impression cylinder 8" column 3, lines 45-48)

Applicants respectfully believe that the Examiner is overlooking the two features in the instant application that a second printing machine has a second impression cylinder and a feed drum disposed immediately up-line of the second impression cylinder for feeding the sheets directly to the second impression cylinder, as recited in claim 1. These two features basically express the same thing, where one feature emphasizes structure and the other function.

A person of ordinary skill in the art cannot arrive at the invention of the instant application according to claim 1 by a combination of Pensavecchia and Stark. The Stark reference teaches a person of ordinary skill in the art away from the present invention and thus away from the subject matter of

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

claim 1. The above-noted text passage from Stark that "after the sheet has been released from the register drum 4, it passes to a second or trailing transfer drum 3 and then goes to an impression cylinder 8" is the exact opposite of claim 1 of the instant application. Stark discloses that the register drum (4) is not disposed immediately up-line of the impression cylinder (8), because in Stark the transfer drum (3) is disposed between the register drum (4) and the impression cylinder (8). Therefore, in Stark the sheet is not directly transferred from the register drum (4) to the impression cylinder (8). Instead, in Stark the sheet is first transferred from the register drum (4) to the transfer drum (3) and then from the transfer drum (3) to the impression cylinder (8). In other words, Stark discloses that the transfer of the sheet from the register drum (4) to the impression cylinder (8) must occur indirectly via the transfer drum (3).

Because Stark teaches that the register drum (4) is not disposed immediately up-line of the impression cylinder (8) and the register drum (4) does not feed sheets directly to the second impression cylinder, while the feed drums (72a and 72b) of Pensavecchia are disposed directly next to the cylinder, Stark teaches a person of ordinary skill in the art away from the combination as suggested by the Examiner.

Applic. No. 09/688,462

Amdt. dated March 2, 2004

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Therefore, the present invention as claimed is not obvious over Pensavecchia in view of Stark.

Furthermore, a critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence."

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 1 is believed to be allowable, dependent claims 14, 16, and 18 are believed to be allowable as well.

In the paragraph bridging pages 3-4 of the Office action, claims 3-11 and 15 have been rejected as being obvious over Pensavecchia (U.S. Patent No. 5,660,108) in view of Stark (U.S. Patent No. 5,040,460) and in further view of Drapatsky et al. (U.S. Patent No. 5,103,733) under 35 U.S.C. § 103. Drapatsky et al. do not make up for the deficiencies of Pensavecchia and Stark. Since claim 1 is believed to be allowable, dependent claims 3-11 and 15 are believed to be allowable as well.

Applic. No. 09/688,462

Amdt. dated March 2, 2004

Reply to Office action of December 2, 2003

In the last paragraph on page 4 of the Office action, claim 17 has been rejected as being obvious over Pensavecchia (U.S. Patent No. 5,660,108) in view of Stark (U.S. Patent No. 5,040,460) and in further view of Giori et al. (U.S. Patent No. 6,101,939) under 35 U.S.C. § 103. Giori et al. do not make up for the deficiencies of Pensavecchia and Stark. Since claim 1 is believed to be allowable, dependent claim 17 is believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1, 3-11, and 14-18 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.



Applic. No. 09/688,462

Amdt. dated March 2, 2004

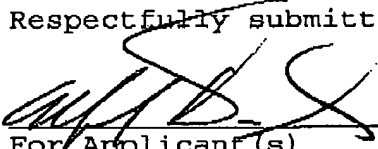
Reply to Office action of December 2, 2003

If an extension of time for this paper is required, petition  
for extension is herewith made.

Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &  
Greenberg P.A., No. 12-1099.

Respectfully submitted,

**Alfred K. Dassler**  
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For Applicant(s)

AKD:cgm

March 2, 2004

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